

REMARKS

Claims 1, 2 and 4-10 and 13-16 remain pending in this application. Claims 1 and 16 are independent. Applicants respectfully request reconsideration and withdrawal of the Final Rejection mailed November 16, 2006, and allowance of the present application.

Corrected PCT Specification

It appears that the Examiner is using the original PCT specification during examination rather than the corrected PCT Specification filed with the WIPO International Bureau, and filed upon entry into the U.S. National Stage.

In the USPTO's "Image File Wrapper", this document was incorrectly categorized as a part of the multi-part file "Documents submitted with 371 Applications" on April 3, 2000, rather than being separately called out as the "specification".

To aid in the Examiner's review and to expedite successful prosecution of this application, the "Corrected Version" of International Publication Number WO 99/23971 (referred to in PCT Gazette No. 29/2000, Section II) has been filed concurrently with this Response.

Applicants believe that all pending objections and rejections should be resolved by consideration of this properly filed corrected document which forms a part of the present National Stage Application under the Patent Cooperation Treaty and the MPEP.

Objections to the Drawings

Withdrawal of the objection to the drawings under 37 CFR 1.83(a) as failing to show multiple conicities and two different sets of threads. Applicants respectfully traverse.

Specifically, Figure 1 of the drawings illustrates two conicities 3d, 3e. The use of two conicities is also described in detail with reference to Figure 1, beginning at line 25 of page 11.

Beginning at line 25, a threaded implant is described as having two conicities, with a thread 3d having a slight conicity angle α , and a thread 3e having a greater conicity angle β .

The specification also discusses the use of multiple thread spirals in detail. Beginning at line 13 of page 8 of the specification, a feature of the embodiments is described as choosing the number of thread spirals, which can be two, three or four. Figures 11 and 12 illustrate the multiple thread spirals, which are further described beginning at line 31 of page 13. Further, the present specification describes that the introduction of multiple thread spirals, *per se*, is known. The multiple thread spirals are interspersed with each other, as seen in Figures 11 and 12, and with reference to respective pitches Ph' and Ph''.

As discussed above, multiple conicities and threads are fully illustrated by the drawing figures of the present specification. Applicants therefore respectfully request withdrawal of the objections to the drawings.

Enablement Rejection Under 35 U.S.C. § 112, ¶1

Withdrawal of the rejection of claims 1, 2, 4-10, and 13-16 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement is requested.

The Examiner states that the recitation of threads having a slight conicity, two sections of differing conicity, and the recitation of bone being forced out upon screwing of the implant in a hole in a bone are not described in the specification so as to enable a person with skill in the art to make and/or use the invention. Applicants respectfully traverse.

The purpose of the enablement requirement is to ensure that the invention is communicated to the public so that those of ordinary skill in the art can make and use the claimed invention.¹ “Detailed procedures for making and using the invention may not be necessary if the description of the invention itself is sufficient to permit those skilled in the art to

¹ See MPEP 2164.

make and use the invention.”² “A patent need not teach, and preferably omits, what is well known in the art.”³ “[T]he Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention.”⁴

The present disclosure as represented by the “Corrected Version” of the published parent PCT application PCT/SE98/01982 clearly satisfies the above standards for enablement.

Specifically, Figure 1 of the drawings illustrates two conicities 3d, 3e. The use of two conicities is also described in detail with reference to Figure 1, beginning at line 25 of page 11. Beginning at line 25, a threaded implant is described as having two conicities, with a thread 3d having a slight conicity angle α , and a thread 3e having a greater conicity angle β .

The specification also discusses the use of multiple thread spirals in detail. Beginning at line 13 of page 8 of the specification, a feature of the embodiments is described as choosing the number of thread spirals, which can be two, three or four. Figures 11 and 12 illustrate the multiple thread spirals, which are further described beginning at line 31 of page 13. Further, the present specification describes that the introduction of multiple thread spirals, *per se*, is known. In addition, support for the claimed subject matter can be found in originally filed claims 1-15.

In light of the above specific but not exhaustive list of citations from the specification, the specification provides a full description of multiple conicities and thread spirals as claimed.

The functional recitation of bone being forced out upon screwing of the implant in a hole in a bone is also fully described in the specification. The description is present, for example, in the originally presented claims 1-15. Applicants point out that the claims as filed in the original specification are part of the disclosure. The description of the implant structure is therefore sufficient to convey the described function to one of ordinary skill in the art.

² *Id.*

³ *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1986).

⁴ *See In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

Therefore, Applicants submit that a person having skill in the art can fully understand and appreciate the novel and non-obvious features of the recited invention from the description contained in the present specification.

Accordingly, withdrawal of the enablement rejection of claims 1, 2, 4-10, and 13-16 under 35 U.S.C. § 112, first paragraph, is therefore requested.

Allowable Subject Matter

Applicants note with appreciation the indication that claims 1, 2, 4-10 and 13-16 would be allowed if the rejection under 35 U.S.C. § 112, *second*⁵ paragraph, is overcome.

In view of the above remarks regarding the drawing objections and 112, ¶1 enablement rejections in light of the originally filed Corrected Version of the parent PCT and concurrently filed herewith, allowance of claims 1, 2, 4-10 and 13-16 is requested.

Conclusion

In view of the above remarks, Applicants believe that each of pending claims 1, 2, 4-10 and 13-16 in this application is in immediate condition for allowance. An early indication of the same would be appreciated.

The Examiner is respectfully requested to enter this Response After Final, in that it raises no new issues, but merely identifies the deficiencies of the Final Office Action. In the alternative, the Examiner is respectfully requested to enter this Response After Final in that it reduces the issues for appeal.

⁵ This is believed to be a typographical error that erroneously refers to 112, ¶2 rather than the pending 112, ¶1 enablement rejection.

Application No.: 09/509,869
Response After Final filed February 8, 2007
In response to Final OA mailed November 16, 2006

Docket No.: 21547-00268-US

Applicants believe that no fee is due with this response. However, for any fee that is due, including fees for extensions of time, please charge CBLH Deposit Account No. 22-0185, under Order No. 21547-00268-US from which the undersigned is authorized to draw.

Dated: February 8, 2007

Respectfully submitted,

By /Larry J. Hume/

Larry J. Hume

Registration No.: 44,163

CONNOLLY BOVE LODGE & HUTZ LLP

1990 M Street, N.W., Suite 800

Washington, DC 20036-3425

(202) 331-7111

(202) 293-6229 (Fax)

Attorney for Applicant

Attachments: "Corrected Version" of WO 99/23971 (referred to in PCT Gazette No. 29/2000, Section II)